

### **Remarks**

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

The Office Action Summary page indicates that the pending claims are claims 1-10 and 12-18. Referring to the Supplemental Preliminary Amendment filed August 31, 2005, Applicants explained that since a claim numbered claim 11 is missing in the originally filed PCT application, as well as the initial Preliminary Amendment, the Supplemental Preliminary Amendment renumbered claims 12-18 as claims 11-17. But to avoid any further confusion in this regard, all of claims 1-18 have now been cancelled, and replaced by new claims 19-36.

New claim 19 corresponds to original claim 1, but has been drafted in a manner to overcome the rejection of claims 1-10 and 12-16 under the first paragraph of 35 U.S.C. §112, as well as the rejection of claims 1-8 and 12 under the second paragraph of 35 U.S.C. §112, as a result of which both of these rejections have been rendered moot.

In drafting new claim 19, the subject matter of renumbered claim 16 (original claim 17) has been incorporated therein. Original claim 17 is not subject to the rejection of the claims under the first paragraph of 35 U.S.C. §112. This is the reason that this rejection has now been rendered moot. The expressions noted by the Examiner in connection with the rejection under the second paragraph of 35 U.S.C. §112 have been avoided in drafting the new claims, thus also rendering this rejection moot.

Claim 19 also expressly states that the substrate is reacted with hydrogen gas, which is based on the disclosure in the specification, for example, at page 11, lines 20-21; the second paragraph from the bottom on page 12; and the General hydrogenation section on page 17. It is apparent from all of these disclosures that hydrogen gas is used for the reaction with the substrate.

New claim 33 is directed to the preferred embodiment of claim 3.

New claim 34 is directed to the preferred embodiments for n, M and X in claim 8.

New claim 35 is directed to the preferred embodiments for n and X in claim 10.

New claim 36 is directed to the preferred embodiments for n and X in renumbered claim 12 (original claim 13).

The patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-9, 13 and 15-18 under 35 U.S.C. §102(b) as being anticipated by Arikawa et al. is respectfully traversed.

Arikawa et al. is **only/solely** directed to catalytic, **asymmetric transfer hydrogenation (ATH)**, whereby two hydrogen atoms are transferred from a donor molecule, namely isopropanol, onto the C=O-group of the substrate. The donor molecule will thus be converted into a ketone. As catalyst, a fivefold coordinated Ru(II)Cl<sub>2</sub>-complex with a mono-dentate phosphine- and a bi-dentate ferrocene-1-oxazoline-2-sec.phosphineligand is used.

Arikawa et al. thus teach the skilled person that specific Ru-complexes could be used for the transfer-hydrogenation of ketones with isopropanol.

In contrast to this, the presently claimed invention is concerned with direct hydrogenation, i.e. where hydrogen gas is used as donor molecules.

Accordingly, Applicants respectfully submit that the rejection based on the Arikawa et al. reference should be withdrawn.

The rejection of claims 1-10, 12, 13 and 15-18 under 35 U.S.C. §102(b) as being anticipated by Nishibayashi et al. is respectfully traversed.

The same arguments apply to this reference as discussed above in connection with the Arikawa et al. reference. That is, as apparent even from the Summary section at the beginning of the Nishibayashi et al. reference, it is directed to **only/solely** asymmetric transfer hydrogenation (ATH), whereas the present invention is directed to use of hydrogen gas as donor molecules.

Therefore, the rejection of the claims based on Nishibayashi et al. should also be withdrawn.

The rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Arikawa et al. is respectfully traversed.

The comments set forth above concerning the Arikawa et al. reference are equally applicable to this rejection. Furthermore, the subject matter of claim 14 is not obvious

from this reference since the chemistry and involved reactions are totally different between **transfer** hydrogenation, and **direct** hydrogenation, i.e. using hydrogen gas.

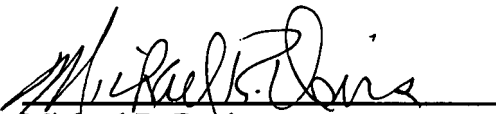
The instant process leads, in comparison to the ATH-processes of the cited prior art, to an unexpected and remarkable higher activity of the catalyst(s). Compare Experiments 1 and 2 (made under typical ATH-conditions, see "Experiments 1 and 2" under Table 1 on page 18 of the specification) with Experiments 3 to 59 in Table 1. Reaction times of one hour are surprisingly low, while having high yields. Even more surprising are the generally high optical yields.

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the applied references.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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